



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,659	11/15/2000	Daniel Geier	7.035	3551

23598 7590 04/25/2005

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.
250 E. WISCONSIN AVENUE
SUITE 1030
MILWAUKEE, WI 53202

EXAMINER

SINGH, SUNIL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,659

Applicant(s)

GEIER ET AL.

Examiner

Sunil Singh

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2-4, 10-23, 25-30 is/are allowed.
- 6) ☒ Claim(s) 1, 5-9 and 31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,5,9,31 are rejected under 35 U.S.C. 102(b) as being anticipated by French document (1567198).

French document '198 discloses an exciter assembly comprising an exciter housing (10); an exciter shaft (12) rotatably journaled in said exciter housing; a fixed eccentric weight (18) rotationally fixed to said exciter shaft; a free swinging eccentric weight (22,24) mounted on said exciter shaft so as to rotate with respect to said exciter shaft between a first angular position in which the eccentricity of said free swinging weight adds to the eccentricity of said fixed weight and a second angular position in which the eccentricity of said free swinging weight detracts from the eccentricity of said fixed weight (see Figs. 2,4), wherein said free swinging weight is mounted on said exciter shaft so as to be restrained from substantial axial movement along said exciter shaft without the use of any retaining structure that is fixed to said free swinging weight. The free weight is restrained from substantial axial movement along said exciter shaft solely by said fixed eccentric weight (18) and another component of said exciter assembly (this is considered as the shaded area between members 14 & 22 and 16 & 24).

Art Unit: 3673

(Re claim 5), the fixed weight is formed integrally with said exciter shaft. Furthermore, it should be noted that it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. In re Hotte, 177 USPQ 326, 328 (CCPA 1973).

With regards to claim 9 (see Figs. 5-8).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over French document '198 in view of Century (U.S. Pat. 3561336).

French document '198 discloses the invention substantially as claimed.

However, French document '198 is silent about his motor having a rotary output shaft which is coupled to the exciter shaft and which is co-axial with the exciter shaft, the motor output shaft being splined directly to the exciter shaft. Century teaches having a motor (70) having a rotary output shaft (80) which is coupled to an exciter shaft (47) and which is co-axial with the exciter shaft, the motor output shaft being splined (81,61) directly to the exciter shaft (see Fig. 2). It would have been considered obvious to one of ordinary skill in the art to modify French document '198 by substituting the motor drive means as taught by Century for the motor drive means of French document '198

Art Unit: 3673

since it would be an obvious design choice to substitute equivalent parts for performing equivalent function. It should be noted that such an arrangement allows for ample backlash and play.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over French document '198 in view of Salani or Polacek (US 4353261, 5082396).

French document '198 discloses the invention substantially as claimed. However, it is silent about using his exciter assembly within a drum. Salani and Polacek both teach using exciter assemblies within a drum (see Figs. 1,2 and 8 respectively). It would have been considered obvious to one of ordinary skill in the art to modify French document '198 to include a drum as taught by either Salani or Polacek since such a modification would provide an easy to assembly vibratory roller.

Response to Arguments

6. Applicant's arguments filed 12/27/04 have been fully considered but they are not persuasive. Applicant's argument is based on a declaration made by Mr. Orzal. On page 2 of applicant's "Remarks" section, it is stated that the shaded unlabeled element between members 14 and 22 and 16 and 24 of the French document '198 is most probably retaining rings or spacers. That being said, applicant's invention is directed to precluding the use of complex ring retainers that positively couple the free weights to the exciter shaft as indicated on page 3 of the applicant's specification. Applicant goes on to say that his exciter assembly does not require "any mounting hardware" instead his free weight is sandwiched solely between the fixed weight and an operative component such as a bearing and/or gears or other torque transfer elements. It should

Art Unit: 3673

be noted that "such as" merely points out examples and in fact the "operative component" can include a "spacer". The examiner is also one of ordinary skill in the art and the examiner agrees with applicant that the shaded unlabeled element between members 14 and 22 and 16 and 24 of the French document '198 is a spacer. Since members (22,24) are free to rotate relative to the shaft the only way they would be positively coupled to a retaining ring would be to be welded/fastened to the ring and the ring would then have to be housed within a groove of the shaft. The examiner fails to see any grooves in the shaft where the "ring" or "spacer" is housed. And if the shaded unlabeled element between members 14 and 22 and 16 and 24 of the French document '198 is welded/fastened to the shaft and then welded/fastened to members (22,24) then members (22,24) would not be free to rotate relative to the shaft. Therefore, the shaded unlabeled element between members 14 and 22 and 16 and 24 of the French document '198 clearly illustrates a spacer element that does not positively couple the free weights to the exciter shaft and as such does not fall into applicant's definition what a "mounting hardware" is but instead falls into applicant's broad all encompassing definition of what an "operative component" is.

Allowable Subject Matter

7. Claims 2-4, 10-23, 25-30 are allowed.
8. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Art Unit: 3673

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3673

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673



SS
SS
4/18/05

SUNIL SINGH
PRIMARY PATENT EXAMINER